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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---|---|
| Proceeding | 91207895 |
| Party | Defendant<br>Virginia Polytechnic Institute and State University |
| Correspondence Address | NORM J RICH - ROBERT S WEISBEIN<br>FOLEY & LARDNER LLP<br>90 PARK AVENUE<br>NEW YORK, NY 10016<br>UNITED STATES<br>IPdocketing@foley.com, rweisbein@foley.com, wwalker@foley.com, nrich@foley.com, tdinkens@foley.com |
| Submission | Other Motions/Papers |
| Filer's Name | Robert Weisbein |
| Filer's e-mail | IPdocketing@foley.com, rweisbein@foley.com, wwalker@foley.com, nrich@foley.com, tdinkens@foley.com |
| Signature | /Robert Weisbein/ |
| Date | 01/29/2016 |
| Attachments | Reply Brief in Support of Motion to Strike.pdf(3818723 bytes ) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

| | |
|---|---|
| HOKIE OBJECTIVE ONOMASTICS SOCIETY LLC,<br><br>Opposer,<br><br>v.<br><br>VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY,<br><br>Applicant. | Opposition No. 91207895<br><br>Serial No.: 85/531,923 |

**APPLICANT'S REPLY BRIEF IN SUPPORT OF MOTION TO STRIKE OPPOSER'S FIRST, THIRD AND FOURTH NOTICES OF RELIANCE OR IN THE ALTERNATIVE MOTION UNDER FED. R. CIV. P. 36(b) TO WITHDRAW THE ADMISSIONS**

Applicant, Virginia Tech, submits this reply brief to address several of the arguments advanced by Opposer, HOOS, in its brief in opposition to Virginia Tech's motion to strike.

## I. PRELIMINARY STATEMENT

Consistent with the guidance provided by Sections 510.03(a) and 528.03 of the TBMP and the legal precedent in *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 U.S.P.Q. 1203 (TTAB 2002), Virginia Tech calculated the date for its responses to HOOS's requests for admissions from the date that it filed its motions for summary judgment and not from the date that the Board issued its suspension Orders. Consequently, there was good cause for Virginia Tech not to respond to HOOS's outstanding discovery requests until the suspensions were lifted. If the admissions were deemed admitted, the harsh result that would befall Virginia Tech is not consistent with the above TBMP sections, the decision in *Leeds*, the case law interpreting Fed. R. Civ. P. 36 (b), or the parties' obligation to cooperate in discovery. Here, HOOS chose gamesmanship over cooperation and transparency in the discovery process, hoping to gain a

procedural advantage over Virginia Tech in a game of "gotcha." Banking on Virginia Tech having served its responses to HOOS's requests for admissions late, HOOS chose to lie in wait until its trial period and then rely on the requests for admission as having been deemed admitted. Although Section 510.03(a) of the TBMP clearly states that "the Board ordinarily treats the proceeding as if it had suspended as of the filing date of the potentially dispositive motion," HOOS nonetheless elected to calculate the due date of Virginia Tech's responses from the date of the Board's order suspending the proceedings. Based on this dubious position HOOS purportedly took no further discovery of Virginia Tech and based its trial strategy on the requests for admission as being deemed admitted.

Notwithstanding the obligation of the parties and counsel to cooperate in the discovery process, HOOS at no time reached out to Virginia Tech to discuss the purported late serving of Virginia Tech's answers to HOOS's requests for admissions. Had HOOS promptly raised the issue during discovery the parties could have sought to resolve the dispute amongst themselves or if that were not possible, raise the issue with the Board to get a ruling as to the timeliness of Virginia Tech's admission answers. Such cooperation would have allowed the parties to formulate their respective strategies for proceeding with discovery and trial without risk. Instead, HOOS tried the sneak attack approach and now claims prejudice if the Board determines that either Virginia Tech's answers were timely filed or that the admissions should be treated as withdrawn. Any such prejudice was self-inflicted and could have easily been avoided. In any event, the alleged prejudice is highly overstated as the paper and deposition discovery that HOOS purportedly would have taken had Virginia Tech's answers been timely served, was already taken in the Hokie Real Estate case. Thus, HOOS already possesses the information that it now seeks. During the initial Rule 26(f) conference counsel for the parties agreed that to the

extent that HOOS sought discovery that was duplicative of the discovery taken in the Hokie Real Estate case it need not be taken again because the parties could rely on that discovery as though it had been taken in this proceeding. The stipulated submission by HOOS of the entire transcript of the Hokie Real Estate hearing testimony of Dr. Wayne D. Massey as part of its trial testimony was made pursuant to that agreement.

## II. TBMP SECTIONS 510.03(a) AND 528.03 APPLY WITH EQUAL FORCE TO MOTIONS FOR SUMMARY JUDGMENT

The Trademark Trial and Appeal Board Manual of Procedure ("TBMP") is a compilation of statutory, regulatory, and decisional authority relevant to Board practice and procedure—a guide for both the Board and practitioners. Section 510.03(a) is entitled "Suspension" and the relevant portion thereof is entitled "Potentially dispositive motions." Section 528.03 is entitled "Suspension Pending Determination of Motion." Both Sections apply with equal force to motions for summary judgment as is evident from the plain language of each section. The introductory sentence of Section 510.03(a) states: "When a party to a Board Proceeding files a motion which is potentially dispositive of the proceedings, such as a motion to dismiss, a motion for judgment on the pleadings, **or a motion for summary judgment,** the case will be suspended by the Board with respect to all matters not germane to the motion." (Emphasis added.) Similarly, Section 528.03 states: "When any party files a motion to dismiss, or motion for judgment on the pleadings, **or a motion for summary judgment,** or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion...." (Emphasis added.) Therefore, HOOS's argument that the suspension of summary judgment motions is governed by Section 528.03 and not Section 510.03(a), and that the Board's suspension orders for summary

judgment motions are not to be retroactively applied whereas they may be for other types of dispositive motions, is simply wrong.

Moreover, there is no logical reason why suspension orders for summary judgment motions are not entitled to retroactive treatment whereas other types of dispositive motions are. Indeed, two of the suspension orders attached to HOOS's brief in support of its position that where the Board believes retroactive treatment is appropriate the order indicates same, are for summary judgment motions. See *Samazon, Inc. v. Amazon Energy LLC*, Cancellation No. 92046723 and *Wal-Mart Stores, Inc. v. Franklin Loufrani*, Opposition Nos. 91150278 and 91154632. These cases further evidence that the suspension of proceedings upon the filing of a motion for summary judgment will ordinarily be retroactively applied. HOOS cites to no case, rule nor TBMP section that stands for the proposition that if the suspension order does not specifically state it is to be applied retroactively the Board in its discretion cannot do so.

## III. GIVEN THE BOARD'S PRACTICE OF ORDINARILY TREATING A SUSPENSION OF PROCEEDINGS AS OF THE FILING OF THE DISPOSITIVE MOTION, VIRGINIA TECH'S DISCOVERY RESPONSES WERE TIMELY SERVED

This is an appropriate case for a suspension order to be issued by the Board to alleviate the need for Virginia Tech to respond to HOOS's discovery requests until after the proceedings have resumed. The purpose of the rule is to spare a litigant from having to expend time, money and effort to respond to discovery where a dispositive motion may result in the dismissal of the proceeding thereby making responding unnecessary. Here, if granted, each of Virginia Tech's motions for summary judgment would have resulted in the complete dismissal of the opposition thereby negating its obligation to respond to HOOS's written discovery.

Looking to TBMP Sections 510.03(a) and 528.03 for guidance, Virginia Tech believed it was entirely appropriate to treat the November 5, 2013 and October 23, 2014 suspension orders

as having been issued as of the filing date of the summary judgment motions, thereby tolling the response dates to HOOS's outstanding discovery. While each of Virginia Tech's motions for summary judgment and requests for suspension of proceedings requested the Board to reset the time for it to respond to discovery, the Board did not act on those requests. Consequently, when the proceedings were resumed Virginia Tech proceeded to respond to the discovery within the period of time it believed it had left to respond at the time the motions were filed.

HOOS argues that Virginia Tech's request in each of its motions to suspend, which accompanied each motion for summary judgment, was a concession that it needed an extension of time to respond to HOOS's outstanding discovery. It also argues that Virginia Tech counsel's January 13, 2014 request to HOOS's counsel for a three-week extension of time to respond to HOOS's discovery was an acknowledgement that the time to respond had already lapsed. These arguments are without merit. It is undisputed that at the time Virginia Tech filed of each of its motions for summary judgment (October 28, 2013 and October 21, 2014) it still had several days within which to serve its responses to HOOS's discovery. The only question is whether or not the Board's suspension orders should be applied retroactively to the date the motions were filed. Recognizing that it only had a few days remaining to respond to HOOS's discovery at the time it filed each of its motions for summary judgment, Virginia Tech believed that the prudent course of action would be to request the Board to reset the time it had to respond to HOOS discovery in the event the motions were denied and the proceedings were resumed. Because the Board did not act on either of Virginia Tech's requests for such an extension, Virginia Tech made certain that its responses were timely served within the remaining time period.

When Virginia Tech's October 28, 2013 motion for summary judgment was denied and the proceedings were resumed by the Board's order of January 8, 2014, Virginia Tech had only

seven days[1] within which to prepare and serve its responses to HOOS's discovery. Therefore, Virginia Tech's counsel reached out to counsel for HOOS by email dated January 13, 2014, requesting a three-week extension of time to respond. Rather than cooperating in discovery, counsel for HOOS ignored the request and never responded, hoping to catch Virginia Tech in a game of "gotcha." Consequently, Virginia Tech served its responses to HOOS's discovery on January 15, 2014, the last day of the remaining seven-day period.

## IV. VIRGINIA TECH'S OCTOBER 28, 2013 MOTION FOR SUMMARY JUDGMENT WAS SUFFICIENT TO WARRANT THE SUSPENSION OF PROCEEDINGS

HOOS raises a novel theory that the filing of a motion with the Board where certain supporting exhibits are inadvertently not filed constitutes the filing of an "incomplete motion" such that the motion should be treated as a nullity. HOOS cites no case law or procedural rule in support of its position. The argument arises out of Virginia Tech's October 28, 2013 motion for summary judgment and request for suspension of proceedings. The motion was supported by the Declaration of Lawrence G. Hincker, which cited to four exhibits. Although the Hincker Declaration was served and filed on October 28, 2013, along with the motion, counsel for Virginia Tech did not electronically file the exhibits to the Hincker Declaration with the Board. On November 5, 2013, when this oversight was discovered, the exhibits were electronically filed with the Board and served on HOOS's counsel, along with a fresh certificate of service. There was no prejudice to HOOS because each of the four exhibits were documents within its possession and with which it was intimately familiar, namely, (i) the Answer, Affirmative Defenses and Counterclaims filed by Hokie Real Estate in the HOKIE trademark litigation with Virginia Tech, where HOOS's sole member, James Creekmore, was counsel to Hokie Real

[1] In its opening brief Virginia Tech erroneously stated that it had eight days to respond to HOOS's discovery requests up and including January 16, 2014. Virginia Tech actually had seven days to respond up to and including January 15, 2014, which is the day its responses were timely served.

Estate along with Keith Finch, HOOS's counsel in this proceeding, (ii) the Settlement Agreement between Hokie Real Estate and Virginia Tech that was negotiated by Messrs. Creekmore and Finch, (iii) the License Agreement between Hokie Real Estate and Virginia Tech that was negotiated by Messrs. Creekmore and Finch, and (iv) HOOS's responses to Virginia Tech's interrogatories. HOOS's "incomplete motion" argument must be rejected.

## V. VIRGINIA TECH TIMELY SERVED ITS RESPONSES TO HOOS'S THIRD AND FOURTH DISCOVERY REQUESTS

The Board denied Virginia Tech's motion for summary judgment based on standing and resumed the proceedings on August 27, 2015. Counting from the date that it filed its motion for summary judgment and request to suspend the proceedings, Virginia Tech believed it had two days remaining to serve its response to HOOS's Third and Fourth Discovery Requests, making the responses due on August 31st. HOOS contends that Virginia Tech's responses were due on August 27th, the very day that the Board issued its order denying summary judgment and resuming the proceedings. Counsel for HOOS claims he never received Virginia Tech's August 31st responses and that it was not until this motion to strike was filed that it saw for the first time the responses attached as Exhibits 8 and 9 to the Weisbein Declaration dated December 23, 2015. The certificate of service affixed to Virginia Tech's responses amply demonstrates that the responses were duly served on August 31, 2015, by William S. Walker, Jr. See Walker Declaration submitted herewith.

HOOS does not dispute receiving Virginia Tech's supplemental responses to HOOS's Third and Fourth Discovery Requests but finds it curious why Virginia Tech would "have gone to the trouble of preparing and serving its September 18 responses (which contain considerably more information than the August 31 responses) when it had no reason to do so." HOOS Brief at 9. As an initial matter, given that the supplemental responses are clearly labeled as such (see

Exhibits 8 and 9 to the Weisbein Decl.) and the responses incorporate all of the initial responses served on August 31st with the supplemental information clearly delineated as such, it should have been readily apparent to HOOS that Virginia Tech served earlier responses that were now being supplemented. This is particularly so since under Fed. R. Civ. P. 26(e) a party who has responded to a discovery request is under an obligation to supplement or correct its response in a timely manner if the party learns that the response is incomplete or incorrect. That Virginia Tech was serving **supplemental** responses under Rule 26(e) should have been a red flag that earlier responses were served and therefore Virginia Tech had not failed to timely respond to HOOS's Third and Fourth Discovery Requests as HOOS had assumed. Yet counsel for HOOS never reached out to counsel for Virginia Tech to inquire further as would have been prudent and, instead, elected to gamble by not taking any further discovery on the issues covered by the requests for admission and simply rely on them as being deemed admitted. HOOS based its discovery and trial strategy betting that the requests for admission would be deemed admitted because Virginia Tech's response were, in its opinion, served a few days late. Such gamesmanship should not be condoned.

## VI. HOOS WOULD NOT BE PREJUDICED BY THE WITHDRAWAL OF THE ADMISSIONS UNDER FED. R. CIV. P. 36(b) BECAUSE IT HAD ALL THE DISCOVERY IT NEEDED TO PROSECUTE THIS CASE

From the outset of this case with the filing by Virginia Tech of a motion to dismiss, its answer to the Amended Notice of Opposition, and opposition to HOOS's motion for reconsideration, Virginia Tech has consistently taken the position that the date of first use of the mark HOKIE has nothing whatsoever to do with the issues in this proceeding, namely the alleged misuse of the ® registration symbol or the genericness or descriptiveness of the mark HOKIE for the educational and entertainment services covered by the application. Consequently, when

responding to each of HOOS's 85 requests for admissions, each of which were directed to Virginia Tech' first use of the mark HOKIE, it objected to the requests on the grounds of relevancy and not being reasonably calculated to lead to the discovery of admissible evidence. Undeniably, the issue of Virginia Tech's first use of the HOKIE mark was hotly contested. As Messrs. Creekmore and Finch are well aware, this issue was also hotly contested in the Hokie Real Estate case as well. Likewise, the issue of Virginia Tech's purported misuse of the ® registration symbol in connection with the HOKIE mark has been hotly contested both in this proceeding and the Hokie Real Estate case, where extensive documents where produced on this issue and the depositions of Lawrence G. Hincker, Associate Vice President for University Relations, and Locke White, Director of Licensing and Trademarks, were taken. Messrs. Hincker and White also testified on this issue at the preliminary injunction evidentiary hearing held in the Hokie Real Estate case.

The prejudice complained of by HOOS arising out of its failure to take discovery on certain matters is both self-inflicted and highly overstated. Moreover, given that the issues in this opposition are whether Virginia Tech misused the ® registration symbol with the mark HOKIE and whether the HOKIE mark is generic or descriptive for the educational and entertainment services covered by the application, discovery on the issue of the first use of the HOKIE mark dating back to the 1970's is simply not relevant or likely to lead to the discovery of admissible evidence. In respect of the misuse of the ® registration symbol, this issue was the subject of extensive discovery in the Hokie Real Estate case including the production of a substantial number of documents including, license agreements, product and trademark usage approval documents between Virginia Tech, its licensees and licensing agent, and emails relating thereto. Furthermore, Messrs. Hincker and White both testified on the issue of misuse of the ®

registration symbol. Thus, HOOS could have availed itself of the parties' agreement to utilize documents and testimony from the Hokie Real Estate case during its trial as it did the Massey hearing testimony, but elected not to. Attached to the Weisbein Declaration submitted herewith are several excerpts from the Hincker and White depositions and hearing transcript regarding the ® misuse issue. To be sure, HOOS had all the discovery it needed on the facts germane to this proceeding, but instead elected to gamble and rely on the facts established through its requests for admissions as being admitted by Virginia Tech. Now confronted with the possibility that its gamble may not have paid off, it is playing the discovery prejudice card by manufacturing "gaps in its case" when, in fact, it possesses this very information and knowingly sought not to use it.

## VII. CONCLUSION

Virginia Tech respectfully requests that its motion to strike or in the alternative, that its admissions be withdrawn under Rule 36(b) of the Fed. R. Civ. P. be granted.

Respectfully submitted,

FOLEY & LARDNER LLP

By: _____

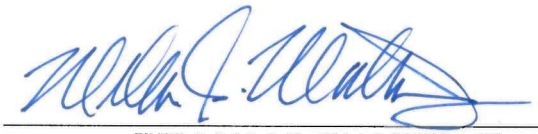
Robert S. Weisbein, Esq.
Norm J. Rich, Esq.
FOLEY & LARDNER LLP
90 Park Avenue
New York, New York 10016
Telephone: (212) 682-7474
Facsimile: (212) 687-2329

*Attorneys for Applicant*
*Virginia Polytechnic Institute and*
*State University*

## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of APPLICANT'S REPLY BRIEF IN SUPPORT OF MOTION TO STRIKE OPPOSER'S FIRST, THIRD AND FOURTH NOTICES OF RELIANCE OR IN THE ALTERNATIVE MOVING UNDER FED. R. CIV. P. 36(B) TO WITHDRAW THE ADMISSIONS, along with the supporting DECLARATION OF ROBERT S. WEISBEIN IN SUPPORT OF APPLICANT'S MOTION TO STRIKE OPPOSER'S FIRST, THIRD AND FOURTH NOTICES OF RELIANCE OR IN THE ALTERNATIVE MOTION UNDER FED. R. CIV. P. 36(B) TO WITHDRAW THE ADMISSIONS and DECLARATION OF WILLIAM S. WALKER, JR. IN SUPPORT OF APPLICANT'S MOTION TO STRIKE OPPOSER'S FIRST, THIRD AND FOURTH NOTICES OF RELIANCE OR IN THE ALTERNATIVE MOTION UNDER FED. R. CIV. P. 36(B) TO WITHDRAW THE ADMISSIONS and addenda thereto, was served by first class U.S. Mail on this 29th day of January, 2016, to Opposer's correspondent of record as follows:

Keith Finch, Esq.
The Creekmore Law Firm PC
318 North Main Street
Blacksburg, VA 24060



WILLIAM S. WALKER, JR.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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|---|---|
| HOKIE OBJECTIVE ONOMASTICS SOCIETY LLC,<br><br>Opposer,<br><br>v.<br><br>VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY,<br><br>Applicant. | Opposition No. 91207895<br><br>Serial No.: 85/531,923 |

**DECLARATION OF ROBERT S. WEISBEIN IN SUPPORT OF APPLICANT'S MOTION TO STRIKE OPPOSER'S FIRST, THIRD AND FOURTH NOTICES OF RELIANCE OR IN THE ALTERNATIVE MOTION UNDER FED. R. CIV. P. 36(B) TO WITHDRAW THE ADMISSIONS**

I, Robert S. Weisbein, under penalty of perjury under the laws of the United States of America, declare as set forth below:

1. I am an attorney licensed by the State of New York, and am a partner with the law firm of Foley & Lardner LLP, attorneys of record for Applicant Virginia Polytechnic Institute and State University ("Applicant") in the above-captioned proceeding.

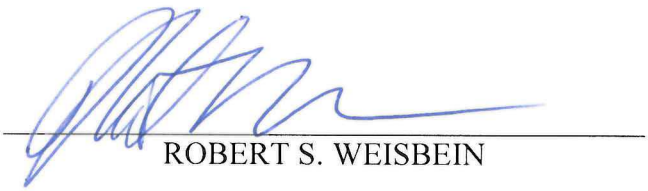
2. I make this declaration in support of Applicant's Motion to Strike Opposer's First, Third and Fourth Notices of Reliance or in the Alternative Motion Under Fed. R. Civ. P. 36(b) to Withdraw the Admissions.

3. Annexed hereto as Exhibit A are true and correct copies of redacted deposition testimony excerpts of Locke White from his deposition dated February 16, 2011, in *VPI&SU v. Hokie Real Estate, Inc.*, No. 7:10-cv-0046, a civil lawsuit in the U.S. District Court for the Western District of Virginia (the "Hokie Real Estate case").

4. Annexed hereto as Exhibit B are true and correct copies of redacted direct examination and cross-examination testimony excerpts of Locke White from a preliminary injunction motion hearing held on February 28, 2011, in the Hokie Real Estate case.

5. Annexed hereto as Exhibit C are true and correct copies of redacted deposition testimony excerpts of Lawrence G. Hincker from his deposition dated February 16, 2011, in the Hokie Real Estate case.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that this Declaration was executed on January 29, 2016, in New York, New York.



ROBERT S. WEISBEIN

# EXHIBIT A

UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF VIRGINIA

ROANOKE DIVISION

| | |
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| * * * * * * * * * * * * * * * * | |
| VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY, | * CIVIL ACTION 7:10-CV-00466 |
| | * FEBRUARY 28, 2011 9:33 A.M. |
| Plaintiff, | * MOTION HEARING |
| | * VOLUME I OF I |
| vs. | * |
| | * |
| HOKIE REAL ESTATE, INC., | * Before: |
| | * HONORABLE GLEN E. CONRAD |
| Defendant. | * UNITED STATES DISTRICT JUDGE |
| * * * * * * * * * * * * * * * * | * WESTERN DISTRICT OF VIRGINIA |

APPEARANCES:

For the Plaintiff:
JOHN HARROLD THOMAS, ESQUIRE
Thomas & Karceski, PC
536 Granite Avenue
Richmond, VA 23226

For the Defendant:
JAMES R. CREEKMORE, ESQUIRE
The Creekmore Law Firm, PC
52 Pondview Court
Daleville, VA 24083

BLAIR N.C. WOOD, ESQUIRE
KEITH FINCH, ESQUIRE
The Creekmore Law Firm, PC
106 Faculty Street
Blacksburg, VA 24060

Court Reporter:
Judy K. Webb, RPR
P.O. Box 1234
Roanoke, Virginia 24006
(540)857-5100 Ext. 5333

Proceedings recorded by mechanical stenography, transcript produced by computer.

Q The registration for the Hokies mark is in the plural form, "Hokies." I'll ask you, is there a registration for the singular form, "Hokie"?

A No, there's not.

Q And why not?

A The university has always felt that there was absolutely no difference between the singular and the plural versions. We always felt that Hokie was exactly the same as Hokies.

REDACTED

REDACTED

BY MR. FINCH:

Q Do you recognize this document?

A Yes.

Q What is this document?

A It's a trademark certificate, I believe.

Q For what term?

A Hokies.

Q Now, is this a registration of the term "Hokie," singular?

A No.

Q You've claimed that you believe the two terms are the same?

A Now I do not claim they're the same.

Q But for a long time you believed that they were the same?

A Yes, absolutely.

REDACTED

REDACTED

BY MR. FINCH:

Q Mr. White, is it true that in your deposition you stated that this third paragraph is consistent with your understanding regarding use of the federal registration symbol?

A No, because I -- as far as singular and plural, I've said before, up until this lawsuit, I thought and the university thought that singular "Hokie," plural "Hokies" was exactly the same. As a matter of this lawsuit, it was brought up, and it was brought to our attention, and we discovered that that was incorrect, and we have made the change.

THE COURT: How have you made the change?

THE WITNESS: Our licensees have access to a website that has all our artwork, and we have changed "Hokie" as the TM and "Hokies" as the registered mark. So we have done that. And we have other plans ready to put into -- to implement as well.

THE COURT: What are those plans?

THE WITNESS: To notify our licensees, if there's any existing product out there. To tell you the truth, we've been buried in this trial for three months, and this is all I've been doing for three months is working on this trial.

# EXHIBIT B

IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF VIRGINIA

ROANOKE DIVISION

| | |
|---|---|
| VIRGINIA POLYTECHNIC INSTITUTE and STATE UNIVERSITY, Plaintiff -vs- HOKIE REAL ESTATE, Defendant | CIVIL ACTION NO.: 7-10-CV-00466 |

FEBRUARY 16, 2011
8:30 a.m.

DEPOSITION OF:

**LOCKE WHITE**

CENTRAL VIRGINIA REPORTERS
P. O. Box 12628
Roanoke, Virginia 24027
(540) 380-5017

REDACTED

Q All right. And so why isn't the word Hokie mentioned here in Section 3.1?

MR. THOMAS: Objection.

THE WITNESS: As far as Hokie or Hokies, we consider them the same, between singular, plural; the University considers them the same trademark.

They are both a trademark. We ended up making the change on the singular back to the TM because Creekmore made it an issue.

REDACTED

REDACTED

Q Here in 11.2, it says, "When checking products," and I'm reading from the third sentence, "When checking product during an audit, the following steps should be taken: Identify the product manufacture or design applier, check for TM or encircled 'R' on each product type, check for the 'licensed collegiate product' label, evaluate product quality/design, and note the trademark or identification used." Is that an accurate description of what you would do?

A Yes.

REDACTED

REDACTED

Q What is the significance of "TM" or the encircled "R" on the product?

A Well, if it is a registered trademark, then it gets the circled R, and if it isn't, then it gets TM or whatever.

REDACTED

REDACTED

Q All right. Are you familiar with the documentation we submitted showing use of the registration symbol, and that is the "R" inside of the circle, in connection with the unregistered term Hokie on a variety of licensed Virginia Tech products?

A Yes.

Q And do you know that only federally registered marks are entitled to use the registration symbol?

A We consider -- or I consider the singular and the plural the same. You made it an issue, so we have gone back to the TM.

Q And you've gone back to the TM, what do you mean?

A Well, on trademarks, our licensees are instructed to use the TM on the singular.

Q I see, and so they have to go back and change all of the existing product to say TM?

A We have not made a decision on existing products yet.

Q How long has it been since you made this decision to tell licensees that they should use TM instead

of the registration symbol on Hokie?

A Say the question again.

Q How long has it been since you made the decision to tell licensees to use TM instead of the registration symbol on Hokie?

A I don't recall. Creekmore brought it up as an issue, and we made the change.

Q All right. But only for new products?

A Correct.

Q All right. So did you inform all of your licensees of this?

A Yes.

Q And how come we haven't seen any of those letters or communications, or did you tell them all by telephone?

A We told them via the Trademarx Online, so all of the artwork was changed. Any new artwork that came through the system, they were told to change on a singular, they were told to change it to the TM.

Q How come we haven't seen any of that in response to our Request for Production of Documents?

MR. THOMAS: Objection.

THE WITNESS: We sent in what we had at the time, and so... I have turned in everything to our

counsel.

REDACTED

Q Is there a way to make an announcement to all of your licensees at once?

A Yes.

Q And you made an announcement about Hokie not requiring the registration symbol anymore?

A I don't believe that we have.

Q All right.

A But they have been notified about the artwork so the artwork that they would access would have the change. Any new artwork that would come through, we are telling them to go back to the TM.

REDACTED

REDACTED

Q When did this message get communicated to all of the licensees, the message about not using the registration symbol in connection with Hokie?

A I don't know the specific date, but it was after you -- it was an issue with Creekmore.

Q And what did the message say?

A I don't remember.

Q And how long was it?

A I don't remember.

REDACTED

Q So if I'm a licensee and I sign onto Trademarxonline.com, what do I see that tells me that I am not supposed to use the registration symbol for Hokie?

A Well, you would go to the artwork page and you would see Hokies with a registered mark and Hokie singular with a TM.

REDACTED

REDACTED

Q Okay. So even if you've approved a T-shirts already, I'm supposed to resubmit that T-shirt every time I make a new manufacturing run of that T-shirt?

A Correct.

Q And that is the point at which you would expect people to notice that the registration symbol is not supposed to be used with Hokie?

A It would just be -- we would notify them. It's not a matter of them noticing it. They submit the artwork, we tell them to make the change.

REDACTED

REDACTED

BY MR. FINCH:

Q All right. So have you ever knowingly required or asked somebody to use the registration symbol on the unregistered term Hokie?

A Again, we consider or I consider Hokie and Hokies to be the same.

REDACTED

BY MR. FINCH:

Q So why do you believe that Hokie and Hokies are the same?

A Well, one is plural and one is singular, but they are all the same.

REDACTED

# EXHIBIT C

IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF VIRGINIA

ROANOKE DIVISION

| | |
|---|---|
| VIRGINIA POLYTECHNIC INSTITUTE and STATE UNIVERSITY, Plaintiff -vs- HOKIE REAL ESTATE, Defendant | CIVIL ACTION NO.: 7-10-CV-00466 |

FEBRUARY 16, 2011
4:00 p.m.

DEPOSITION OF:

**LAWRENCE G. HINCKER**

CENTRAL VIRGINIA REPORTERS
P. O. Box 12628
Roanoke, Virginia 24027
(540) 380-5017

REDACTED

Q Do you know whether the word "Hokie" is a federally registered mark?

A "Hokies" is the registered mark.

Q Is "Hokie" registered?

A It is not registered that way, no.

Q So you may be aware that we've submitted several examples of the University's -- well, of use of the registration symbol together with the term Hokie. Are you aware of that?

A Yes, I am aware of that.

Q So has the University prepared any instructions to its licensees regarding removal of the registration symbol marking from any goods?

A Removal, I don't understand.

Q Well, do you happen to have an understanding of whether the circled "R" is or is not appropriate for the term Hokie?

A The University does not distinguish between the singular and the plural version.

REDACTED

BY MR. FINCH:

Q So has the University told its licensees

whether to use the TM or the circled "R" with Hokie?

A I do not know, because the correspondence and the direction between the licensees and the University would be at Locke's direction and under Locke's hand.

REDACTED

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

| | |
|---|---|
| HOKIE OBJECTIVE ONOMASTICS SOCIETY LLC,<br><br>Opposer,<br><br>v.<br><br>VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY,<br><br>Applicant. | Opposition No. 91207895<br><br>Serial No.: 85/531,923 |

**DECLARATION OF WILLIAM S. WALKER, JR. IN SUPPORT OF APPLICANT'S MOTION TO STRIKE OPPOSER'S FIRST, THIRD AND FOURTH NOTICES OF RELIANCE OR IN THE ALTERNATIVE MOTION UNDER FED. R. CIV. P. 36(B) TO WITHDRAW THE ADMISSIONS**

I, William S. Walker, Jr., under penalty of perjury under the laws of the United States of America, declare as set forth below:

1. I am Notary Public licensed by the State of New York, and I am employed by the law firm of Foley & Larder LLP, attorneys of record for Applicant Virginia Polytechnic Institute and State University ("Applicant") in the above-captioned proceeding, as a legal assistant to the attorney, Robert S. Weisbein.

2. I have personal knowledge about the matters described in this declaration as set forth below.

3. I make this declaration in support of Applicant's Motion to Strike Opposer's First, Third and Fourth Notices of Reliance or in the Alternative Motion Under Fed. R. Civ. P. 36(b) to Withdraw the Admissions.

4. I am fully familiar with Section 113 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") with respect to the service of papers in general and with TBMP Section 113.06 with respect to Certificates of Service in particular.

5. On August 31, 2015, as indicated in the Certificate of Service that I prepared and signed, I served Applicant's responses to HOO's Third and Fourth Sets of Discovery Request by United States First Class Mail on Opposer's correspondent of record, Keith Finch, at The Creekmore Law Firm PC in Blacksburg, Virginia, by causing a true and complete copy of Applicant's responses to be deposited with the United States Postal Service in a postage pre-paid envelope addressed to Mr. Finch. A true and correct copy of said Certificate of Service is attached hereto and made a part hereof as Exhibit A.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that this Declaration was executed on January 29, 2016, in New York, New York.

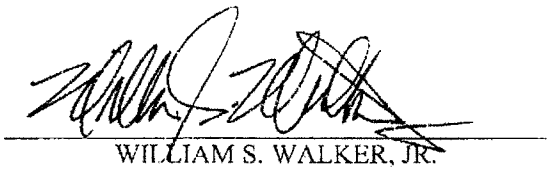
WILLIAM S. WALKER, JR.

# EXHIBIT A

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing APPLICANT VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY'S RESPONSES TO OPPOSER HOKIE OBJECTIVE ONOMASTICS SOCIETY LLC'S FOURTH DISCOVERY REQUESTS, was served by first class mail on this 31st day of August, 2015, to Opposer's correspondent of record as follows:

Keith Finch, Esq.
The Creekmore Law Firm PC
318 North Main Street
Blacksburg, VA 24060



WILLIAM S. WALKER, JR.